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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,776	08/22/2001	Charles M. Lieber	H00498.70054/TJO/DPM	8935

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WOLF GREENFIELD & SACKS, PC
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON, MA 02210-2211

EXAMINER

HU, SHOUXIANG

ART UNIT PAPER NUMBER

2811

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/935,776	Applicant(s) LIEBER ET AL.	
	Examiner Shouxiang Hu	Art Unit 2811	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 December 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-47, 49-72, 75, 76, 97-111, 113-116, 118-201, 261, 262 and 334-500 is/are pending in the application.
4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) See Continuation Sheet is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/06/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3,4,9-31,49-55,102-105,109,111,113-116,121-174,176-180,182,184,185,190,192,193,196-201,261,262,334-373 and 378-500.

Continuation of Disposition of Claims: Claims rejected are 1,2,5-8,32-47,56-72,75,76,97-101,106-108,110,118-120,175,181,183,186-189,191,194,195 and 374-377.

DETAILED ACTION

Election/Restrictions

1. Claims 334-373 and 378-500 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention (directed to a method), according the election made on 1/29/2003, wherein claims drawn to a product were elected.

Therefore, claims 1-47, 49-72, 75-76, 97-111, 113-116, 118-201, 261-262 and 334-500 are pending in this application. Among them, claims 3, 4, 9-31, 49-55, 102-105, 109, 111, 113-116, 121-174, 176-180, 182, 184, 185, 190, 192, 193, 196-201, 261, 262, 334-373 and 378-500 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention; and, claims 1, 2, 5-8, 32-47, 56-72, 75, 76, 97-101, 106-108, 110, 118-120, 175, 181, 183, 186-189, 191, 194, 195 and 374-377 remain active in this office action.

Claim Objections

2. Claims 1, 2, 5-8, 32-47, 56-72, 75, 76, 97-101, 106-108, 110, 118-120, 175, 181, 183, 186-189, 191, 194, 195 and 374-377 are objected to because of the following informalities and/or defects:

These claims each recite the subject matters of an electrical device comprising at least four semiconductors; but they fail to define what are the physical and/or positional relationships between them and/or individual functionalities for them.

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In claims 1 and 56, the term of "the population of semiconductors" lacks a sufficient antecedent basis in the claim.

Claim 57 fails to clarify what is the relationship between the four semiconductors recited in claim 56 and the "one" recited in claim 57.

In claim 57, the term of "the first" lacks a sufficient antecedent basis in the claim

Claims 43-47 and 58-61 each recite the subject matters regarding the length/diameter ratios of the semiconductors in a device that has at least four such semiconductors, but the original disclosure lacks an adequate description regarding what the length/diameter ratios should be in a device having four such nanowires. And, applicant's relevant arguments in the 12-06-2004 amendment fail to point out where in the specification such ratio limitations in a device structure (rather than in a free-standing state) are disclosed and/or discussed.

In claims 62-71, the term of "the point" lacks a sufficient antecedent basis in the claim.

Claims 183 fails to clarify what are the relationship between the recited "at least one semiconductor" and the four semiconductors already defined in claim 110.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 99-101 and 106-108, as being readable on applicant's elected species, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 99-101 and 106-108 recite the subject matter(s) of four bulk-doped semiconductor that exhibit coherent transport, no scattering, ballistic transport and/or Luttinger liquid behavior. However, the specification lacks an adequate description regarding how such four doped IV-IV semiconductor can still possess such recited characteristics, and how a material with such characteristics can still be used in the elected species involving at least one field effect transistor, and what kind of device/element can be formed with such four semiconductors. And, applicant's relevant arguments in the 12-06-2004 amendment are not pervasive, because, as being supported by the elected species, the claimed invention here is drawing to a field effect transistor, which requires the semiconductors to be doped with impurities. And, such impurities would make the resulting nanowires no longer possess the properties of "coherent transport", "no scattering", "ballistic transport" and/or "Luttinger liquid behavior."

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 5, 32-47, 56-72, 75, 76, 97-101, 106-108, 110, 118-120, 175, 181, 183, 186-189, 191, 194, 195 and 374-377, insofar as being in compliance with 35 U.S.C. 112 and as being best understood in view of the claim objections above, are rejected under 35 U.S.C. 102(e) as being anticipated by Kuekes et al. ("Kuekes"; US 6,559,468; of record).

Kuekes discloses an electrical device (Figs. 6 and 7), comprising more than four nanowire field effect transistors (Fig. 6), each of them comprises: a doped semiconductor (14) having a diameter as small as less than 5 nm (see col. 4, lines 52-54), and its variation in diameter as shown in Fig. 6 is apparently less than 20%. And, it further includes an exterior shell (22).

It is noted that the process limitations on how the recited nanosized semiconductors are made, selected and/or deposited as recited in these claims would not carry patentable weight in the claims drawing to a structure, because distinct structure is not necessarily produced. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claims 44-46 and 59-61, as being supported by the elected species, the semiconductor (14) in Kuekes can be naturally extended in the matrix structure shown in Fig. 7. And, the dimension of such matrix can be naturally larger than 1

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micrometer, which then naturally meets the limitation about the recited ratio being larger than 1000:1, since the diameter of the nanowire in Kuekes can be as small as about 0.1 nm (see col. 4, lines 52-54).

Regarding claims 99-101 and 106-108, insofar as being in compliance with 35 U.S.C. 112, the nanowire in Kuekes would naturally have the characteristics substantially same as that of the claimed invention, as they both have a material and dimension substantially the same to each other.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 and 8, insofar as being in compliance with 35 U.S.C. 112 and as being best understood in view of the claim objections above, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuekes.

The disclosure of Kuekes is discussed as applied to claims 1, 2, 5, 32-47, 56-72, 75, 76, 97-101, 106-108, 110, 118-120, 175, 181, 183, 186-189, 191, 194, 195 and 374-377 above.

Although Kuekes does not expressly disclose that the semiconductors can also be formed of SiC, one of ordinary skill in the art would readily recognize that SiC is one of the several semiconductors most commonly used in the art, and it has better high

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temperature performance, compared with that of silicon, as readily evidenced in the prior art such as Morales et al. ("Morales"; Science, V279, pages 208-211; of record).

Therefore, it would have be obvious to one of ordinary skill in the art at the time the invention was made to make the device of Kuekes with the semiconductor(s) being formed of SiC, so that an electrical device with improved high temperature performance would be obtained.

Response to Arguments

8. Applicant's arguments with respect to the rejected claims above have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shouxiang Hu whose telephone number is 571-272-1654. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie C. Lee can be reached on 571-272-1732. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SH
March 4, 2005



SHOUXIANG HU
PRIMARY EXAMINER